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*Amendment*  
*Attorney Docket No. S63.2N-8429-US04*

**Amendments To The Drawings:**

Attached herewith is a replacement sheet for Fig. 5 in which Fig. 5 has been renumbered as Fig. 5A. Two new drawing sheets are also attached herewith in which new Figs. 5B and 5C are presented.

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### **Remarks**

This Amendment is in response to the Office Action dated **November 15, 2005**.

In the Office Action: 1) the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter, 2) the drawings were objected to under 37 CFR 1.83(a) for failing to show every feature of the claimed invention, 3) the Office Action stated that including previously cancelled claims 39 and 40 was in a prior amendment was improper, 4) claims 34, 35, 42, 43, 44, and 47 were rejected under 35 USC §102(e) as being anticipated by US 6,348,065 (hereinafter Brown), 5) claims 34, 35, 42, 43, 44, and 47 were rejected under 35 USC §103(a) as being anticipated by Brown alone according to MPEP § 2113, 6) claims 34, 35, 42, 43, 44, and 47 were rejected under 35 USC §102(e) as being anticipated by US 5,716,393 (hereinafter Lindenberg), 7) claims 34, 35, 42, 43, 44, and 47 were rejected under 35 USC §103(a) as being unpatentable over Lindenberg alone according to MPEP § 2113, 8) claims 34, 35, 37, 42-45 and 47-48 were rejected under 35 USC §102(e) as being anticipated by US 6,027,526 (hereinafter Limon), 9) claim 48 was rejected under 35 USC §103(a) as being unpatentable over Limon in view of US 5,104,404 (hereinafter Wolff), US 5,449,373 (hereinafter Pinchasik) or US 5,591,197 (hereinafter Orth). The following comments are presented in the same order as in the Office Action with section numbers corresponding to the above enumeration.

#### **1) Specification**

The specification was objected to as failing to provide proper antecedent basis for the language of claim 38 requiring a tapered flow path. Blood vessels carry blood throughout the body. Portions of the blood vessels can have a tapered diameter. The function of a stent is to "maintain the diameter of the stented vessel segment slightly larger than the native unobstructed

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vessel segments proximal and distal to the stented segment” (Specification, Page 2). To prevent dissection of the vessel by a stent with a diameter larger than the vessel diameter or obstruction of blood flow because the stent has a diameter smaller than the vessel diameter, a stent should be tapered similar to the tapered blood vessel (Specification, Pages 4 and 17). Thus, it is clear that within the context of the present disclosure that the use of a stent to provide support of a tapered vessel will also include the provision of a correspondingly tapered flowpath in order to maintain proper blood flow as stated above. Applicant therefore requests withdrawal of this objection.

**2) Drawings**

The Office Action objected to the Drawings under 37 CFR 1.83(a) as not showing every feature present in Claim

Applicant submits herewith new Figs. 5B and 5C. Fig. 5 as originally filed has been renumbered as Fig. 5A. Support for Fig. 5B is found in the specification on page 18, lines 1-7. Support for Fig. 5C is found in Fig. 5 as originally filed as well as in the specification on page 17, lines 7-21. Figure 5 as originally filed illustrates an unexpanded stent with various amounts of strut length cut off by representing the cut off lengths as shaded. As discussed in the specification at page 17, lines 7-21, such a stent will have a gradual taper from proximal end (12) to distal end (14) when the stent is in an expanded form. New Fig. 5C is merely an illustration of the gradual taper of the stent in Fig. 5 as originally filed when it is in an expanded form. The specification on page 18, lines 1-7 also discussed other means by which a stent could be tapered when in an expanded form and stated that changing the stiffness of the connecting struts by altering the length of the connecting struts would provide a tapered expanded stent. New Fig. 5B is merely an illustration of an unexpanded stent that has a tapered expanded form due to a change in the length of the connecting struts as discussed in the specification. The illustration of the

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tapered expanded form of the stent in new Fig. 5B, discussed in the specification as filed, is found in new Fig. 5C.

No new matter has been added by the amendments. The specification has been suitably amended to reference new Fig. 5B, 5C and relabeled Fig. 5A. Withdrawal of the objection is respectfully requested.

**3) Improper Amendment - Previously Cancelled Claims**

The Office Action stated that the previous amendment to the claims was improper because it included text of cancelled claims 39 and 40. The instant recitation of the claims properly labels claims 39 and 40 as cancelled.

**4) 35 USC §102(e) Rejections under Brown**

The Office Action rejected claims 34, 35, 42, 43, 44, and 47 were rejected under 35 USC §102(e) as being anticipated by Brown.

Claim 34: The Office action stated that Brown disclosed a stent having a tapered configuration because the struts are arranged to extend from a junction portion of a "V" to a wider portion of a "V". The Office Action went on to state it viewed Applicant's previous arguments indicating that "tapering" means tapering diameters and not tapering struts were not persuasive. Though Applicant continues to disagree with the position stated in the Office Action, in order to further facilitate prosecution of this matter however, Applicant has amended claim 34 to explicitly define taper such that it is not disclosed by the "V" shaped struts of Brown. Applicant however does not concede to the Office Action's construction of the term "taper" and reserves the right to claim an embodiment using the previous claim language in a continuation application or to argue the construction of this claim on appeal.

Claim 35: Dependent claim 35 depends from base claim 34 which for at least the

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reasons mentioned above is not disclosed by Brown. As a result, dependent claim 35 is also not disclosed by Brown.

Claim 42: As in claim 34, base claim 42 has been amended to explicitly include a definition of taper not disclosed by Brown. As a result, for at least the same reason claim 34 is not disclosed by Brown claim 42 is not disclosed by Brown.

Claims 43 and 44: Dependent claims 43 and 44 both depends from base claim 42 which for at least the reasons mentioned above is not disclosed by Brown. As a result, dependent claims 43 and 44 are also not disclosed by Brown.

Claim 47: Claim 47 is not disclosed by Brown for at least the same reasons that claim 34 is not. In addition, Brown does not disclose a stent in which one annular element has a different degree of flexibility than another annular element. The Office Action stated that the feature of claim 47 in which one annular element has a different degree of flexibility from than the other annular element was not novel because machine tolerances present in the manufacture of Brown would cause at least slight differences which would inherently result in slightly different flexibilities. The assertion that Brown inherently meets the language of claim 47 is erroneous however because differences in flexibility as a result of machining tolerances are not necessarily inherently present in Brown.

"A claim limitation is **inherent** in the prior art if it is **necessarily present** in the prior art, **not merely probably or possibly present**. '[T]he dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim [limitation] was disclosed in that single reference.'"

*Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186, 1190 (CA FC 2003) citing *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 [66

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USPQ2d 1801] (Fed. Cir. 2003) (internal quotation marks and alterations omitted) (emphasis added by Applicant). Under the Federal Circuit's decision in *Roscoe Inc. v. Mirror Lite Co.*, 64 USPQ2d 1676 (CA FC 2002), Examiner's assertion that claim 47 is invalid under 35 USC § 102(e) (or 35 USC § 103(a)) because of inherency is in error.

**5) 35 USC §103(a) Rejections under Brown**

The Office action stated that 34, 35, 42, 43, 44, and 47 would have been obvious in light of Brown if viewed according to the Product by Process doctrine of MPEP § 2113. As previously mentioned in section 4 however, these claims have been amended to define taper in a manner not disclosed by Brown. As a result, these claims are not obvious under MPEP § 2113.

**6) 35 USC §102(c) Rejections under Lindenberg**

The Office Action rejected claims 34, 35, 42, 43, 44, and 47 under 35 USC §102(e) as being anticipated by Lindenberg.

Claim 34: Without prejudice or disclaimer, and in order to further facilitate prosecution of this matter, Applicant has amended claim 34 to explicitly limit the scope of the claim to a stent having ends with different sized diameters. Lindenberg does not disclose a stent having ends with different sized diameters.

Claim 35: Claim 35 depends from base claim 34 which for the reasons mentioned above is not disclosed by Lindenberg. As a result, dependent claim 35 is also not disclosed by Lindenberg.

Claim 42: Instant claim 42 has been amended with the same reservations to include the same limitations as present in instant claim 34 which for the reasons mentioned above is not disclosed by Lindenberg.

Claims 43 and 44: Claims 43 and 44 depend from base claim 42 which for the

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reasons mentioned above is not disclosed by Lindenberg. As a result, dependent claims 43 and 44 are also not disclosed by Lindenberg.

Claim 47: Instant claim 47 is not disclosed by Lindenberg for at least the same reasons that claim 34 and 42 are not. In addition, claim 47's recitation of annular elements with different degrees of flexibility is also not disclosed by Lindenberg.

The Office Action stated that the feature of claim 47 in which one annular element has a different degree of flexibility from than the other annular element was not novel because machine tolerances present in the manufacture of Lindenberg would cause at least slight differences which would inherently result in slightly different flexibilities. As described in detail in the discussion of claim 47 in section 4, the Federal Circuit's decision in *Roscoe Inc. v. Mirror Lite Co.*, 64 USPQ2d 1676 (CA FC 2002) renders this assertion of invalidity because of inherency erroneous.

**7) 35 USC §103(a) Rejections under Lindenberg**

As explained in section 6 of this amendment, claims 34, 35, 42, 43, 44, and 47 have been amended to include limitations neither present nor obvious over Lindenberg.

**8) 35 USC §102(e) Rejections under Limon**

Claims 34, 35, 37, 42-45 and 47-48 were rejected under 35 USC §102(e) as being anticipated by Limon. Unlike in Applicant's instant claims, Limon does not disclose a tapering stent in which at least some of the taper traverses a portion of the length where the annular elements are of substantially equal width. (See Limon FIGs. 13, 17, and 18 where all of the tapering occurs as a result of the differing widths of the annular elements causing differing stent diameters). For at least this reason the 35 USC §102(e) rejection is overcome.

**9) 35 USC §103(a) Rejections over Limon in view of Wolff, Pinchasik, or Orth**

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Claim 48 was rejected under 35 USC §103(a) as being unpatentable over Limon in view of Wolff, Pinchasik, or Orth. As indicated above, claim 48 has been amended to include all of the features of dependent claim 49. In the Final Office Action no specific prior art rejection was made to claim 49. None of the references cited in the Final Office Action teach or suggest all of the elements of instant claim 48. For at least this reason the rejection is overcome.

### Conclusion

Based on the previous remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 34, 35, 37, 42-45, 47, and 48 are requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: February 15, 2006

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